

REMARKS

This paper is in response to the Office action dated June 27, 2007, wherein claims 45-64 were pending and rejected.

Main claim 45 is now amended to include the element of dependent claim 54, and claim 54 is canceled. Claim 45 is also amended to overcome the rejection under 35 USC § 112, second paragraph. New dependent claim 65 is added to recite one particular sequence of the method, support for the amendment being found in Example I at page 11, lines 3-11, for example). No new matter has been added.

Claim Rejection – 35 USC § 112, ¶ 2

As best understood by the applicant, claim 45 was rejected as indefinite on the basis that the claim recites “a conjugated diene” compound selected from a Markush group which includes as a member of the group mixtures of myrcene isoprene (paragraphs 1 and 2, p. 2 of official action).

It is respectfully submitted that the claim is not indefinite on this basis; however, in order to overcome the rejection and advance the application to issuance the claim has been amended to recite “a conjugated diene component” selected from the group consisting of myrcene, isoprene, and mixtures thereof. Thus, the conjugated diene component can be myrcene, isoprene, or any mixture thereof. Reconsideration and withdrawal of the rejection are requested.

Claim Rejections – 35 USC § 103(a)

Claims 45-64 were rejected under 35 USC § 103(a) as obvious in view of the combination of Babler U.S. Patent No. 6,278,016 and Clark GB 1 172 516 (paragraphs 3-13, pp. 2-5 of official action).

Paragraph 5 of the official action states that the application names joint inventors, however the application was filed only in the name of James H. Babler. Review and correction of the Office’s records, if necessary, is respectfully requested.

Paragraph 7 of the official action appears to provide a summary of the claims of the present application. The applicant does not acquiesce to the accuracy or the relevance of the summary provided in paragraph 7. The application is to be examined based on the invention as claimed. See MPEP 2106 (“The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined.”)

Paragraph 10 of the official action appears to provide a summary of the differences between the prior art and the claims of the present application. Apparently, the only difference that the Office finds between the claims and the prior art is that “[b]oth cited prior art references are silent on pre-heating the solution comprising at least one alkanolic acid prior to the reaction with the conjugated diene.”

First, it is respectfully submitted that the methods recited in claims are not limited to ones in which “the solution comprising at least one alkanolic acid [is heated] prior to the reaction with the conjugated diene.” The claim language itself does not impose any such sequence. New claim 65, supported by the disclosure of Example I, for example at page 11, lines 10-11, recites the opposite sequence.

Second, it is respectfully submitted that there are other differences between the claims presented and the prior art, which were not addressed in the official action.

Paragraph 11 addresses the supposed difference of a pre-heating step, which is not a part of the claimed invention and, thus, is irrelevant.

Paragraph 12 addresses recitation of alternate temperature ranges, presumably in relation to dependent claims 57 and 58.

The official action has not addressed all of the independent and dependent claims, and thus is incomplete. See MPEP 2106:

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement.

It is respectfully submitted that the official action is incomplete in part, no reasons for rejection under § 103(a) having been given for specific claims, but rather a blanket obviousness rejection was provided for all claims. For an official action to be complete, an explanation must be provided as to why each claim, including each of the dependent claims, is allegedly obvious.

The patent statute requires that the reason must be provided for a rejection of a claim. See 35 USC § 132(a): “Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating

the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application.”

The requirements for thoroughness of an action are described in Rule 104 under 37 CFR: “[t]he examination shall be complete with respect to both to compliance of the application or patent under reexamination with the applicable statutes, rules, and other requirements, and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated. . . . The reasons for any adverse action or any objection or requirement will be stated and such information or references will be given as may be useful in aiding the applicant . . . to judge the propriety of continuing the prosecution.” See also MPEP § 707 Completeness and Clarity of Examiner’s Action.

It is respectfully suggested that if the rejections of the claims are maintained, then the reasons for the rejections of each claim should be provided with the subsequent written Office action, and the action cannot be made final.

In particular, claims 54, 63, and 64 were not examined and rejected with the specificity required by the rules.

The element of claim 54, directed to use of a base, has now been incorporated into independent claim 45. Independent claims 63 and 64 also recite use of a base.

It is submitted that the prior art does not teach or suggest use of a base.* The official action did not identify any such disclosure or suggestion in the prior art.

Furthermore, as described in the present application the inclusion of a base as claimed has the unexpected effect of lowering the amount of undesirable by-products such as cyclic by-products. Thus, even if a *prima facie* case of obviousness were to be established based on new prior art, the unexpected results, and particularly the comparative data described below, are sufficient to overcome a *prima facie* case of obviousness.

* The prior art Babler patent, U.S. Patent No. 6,278,016 also does not teach or suggest carrying out the reaction without a catalyst, as stated in paragraph 8 of the official action on page 3. The reaction scheme in column 3 of the ‘016 patent clearly includes use of an acid catalyst. See lines 34-35 and 45-46.

See Example I, pages 11-13, particularly page 11, lines 25-27 ("In Example I [which employed sodium acetate], trace amounts (less than 5% of the product mixture obtained from myrcene) of the latter type of undesirable by-products could be detected") and page 11, line 30, to page 12, line 1 ("In an experiment similar to Example I, sodium acetate was not added to the reaction mixture, thereby resulting in an increase (approximately 10% of the product mixture obtained from myrcene) in the formation of the latter undesirable cyclic by-products). This effect, reduced production of by-products by use of a base in the reaction solution, is not taught or suggested in the cited prior art.

In contrast, Example 2 according to the invention of GB '516, which did not use a base as claimed, included 15% myrcenyl acetate and 12% α -terpinyl acetate, in addition to the desired neryl and geranyl acetates.

Thus, it is respectfully submitted that the invention as now claimed is allowable. Such action is requested.

CONCLUSION

In the absence of more pertinent prior art, withdrawal of the rejections and allowance of all pending claims are respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the examiner is urged to telephone the undersigned attorney at the indicated number.

Respectfully submitted,

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October 16, 2007

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